

REMARKS

The above-captioned application is a 35 U.S.C. § 371 National Phase application of International Application No. PCT/US99/30004, which claims priority from U.S. Application Serial Nos. 09/223,919 and 09/224,604, both filed December 31, 1998.

Claims 1-2 and 17-21 will be pending in this application after entry of this amendment and response. Claims 1-2 stand rejected. Claims 3-16 have been withdrawn from consideration. Claims 1-2 have been amended. Claims 3-16 have been canceled. Claims 17-21 have been added.

This amendment and response has been prepared according to the USPTO's revised amendment format.

Title

The Examiner has objected to the Title as not being clearly indicative of the invention to which the claims are directed. Applicants disagree with the Examiner's assertion. However, in order to further prosecution, applicants have amended the Title to " MONOCYTE-DERIVED HOMOLOG OF FDF03 PROTEIN". Accordingly, withdrawal of the objection to the Title is respectfully requested.

Priority

The Examiner has objected to applicants' claim for priority, stating that the subject matter of claims 1-2 only finds support in PCT/US99/30004, filed December 29, 1999. Applicants disagree.

Claims 1-2, as amended, are directed to an isolated polypeptide consisting of the amino acid sequence of SEQ ID NO: 6. As stated from pages 6-8 of the published

PCT application and pages 6-9 of the sequence listing, SEQ ID NO: 6 is directed to the FDF03 homolog designated FDF03-S1.

The above-captioned application is a 35 U.S.C. § 371 National Phase application of International Application No. PCT/US99/30004, which claims priority from U.S. Application Serial Nos. 09/223,919 and 09/224,604, both filed December 31, 1998. Applicants agree with the Examiner that the homolog FDF03-S1 finds support in International Application No. PCT/US99/30004. However, applicants further submit that support for the homolog FDF03-S1 can be found in United States Application Serial No. 09/224,604. Specifically, support for FDF03-S1 can, for example, be found in the 09/224,604 application at page 6, line 21 to page 7, line 29, and at pages 27-30 (SEQ ID NOs: 3 and 4). Accordingly, withdrawal of the objection to applicants' claim for priority is respectfully requested.

Rejection under 35 U.S.C. § 102(a)

Claims 1-2 stand rejected under 35 U.S.C. § 102(a) as being anticipated by International Publication No. WO 98/25959 ("Escobedo"). Specifically, the Examiner has stated that SEQ ID NO: 21 of Escobedo is 100% identical to applicants' SEQ ID NO: 6.

Independent claim 1 has been amended to recite an isolated polypeptide consisting of the amino acid sequence of SEQ ID NO: 6 (emphasis added). Escobedo does not disclose or suggest a polypeptide consisting of the amino acid sequence of SEQ ID NO: 6. Claim 2 depends from claim 1. Therefore, applicants submit that the claims, as amended, are novel in light of Escobedo. Accordingly, withdrawal of the rejection of claims 1-2 under 35 U.S.C. § 102(a) in view of Escobedo is respectfully requested.

New Claims

Claims 17-21 have been added. Claims 17 and 18 depend from claims 1 and 2 respectively and are directed to polypeptides encoded by specific nucleic acid sequences. Claim 19 is an independent claim that is directed to a polypeptide encoded by a specific nucleic acid sequence. Claims 20 and 21 are derived from canceled claims 15 and 16 respectively, but have been amended to depend from claim 19. Applicants request that claims 20-21 be rejoined in the application pursuant to M.P.E.P. § 821.04. Support for the new claims can be found, for example, in the originally filed claims and in the sequence listing. Accordingly, no new matter has been added by the addition of new claims 17-21.

CONCLUSION

Applicants submit that the amended claims are not anticipated by the cited reference. Accordingly, reconsideration of the rejection and allowance of the claims at an early date are earnestly solicited.

If the undersigned can be of assistance to the Examiner in addressing issues to advance the application to allowance, please contact the undersigned at the number set forth below.

Respectfully submitted,



Michael G. Biro
Reg. No. 46,556

Schering-Plough Corporation
Patent Department
Mail Stop K-6-1, 1990
2000 Galloping Hill Road
Kenilworth, NJ 07033-0530

Phone: (908) 298-5098 Fax: (908) 298-5388